UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,105	08/28/2001	John F. Buford	01-8001	5844

32127	7590	12/08/2004		EXAMINER

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ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is response to the Applicant's amendment filed on 9/30/2004.

2.   Claims 27, 37, 46 and 51are amended.

Response to Arguments

3.   Applicant's arguments filed on 9/30/2004, with respect to claims 27, 37, 46 and 51 have

been fully considered but they are not persuasive, for the reason set forth below.

4.   Applicant argued that the cited prior art (Miloslavsky et al., U.S. Pat. No. 6,581,105) does

not anticipated the claimed limitations of "wherein the parsing step includes breaking up an

electronic mail message nested in the complaint into the plurality of components" as recited in

claims 27, 37, 46 and 51, as amended.

In response to the applicant's argument, the law of anticipation requires that a distinction

be made between the invention described or taught and the invention claimed. It does require that

the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior

art", it is only necessary that the claims under consideration "read on" something disclosed in the

reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Colman*

v. Kimberly-Clark Corps., 218 USPO 798.

Applicant's arguments are not found persuasive. Claims 27 and 37 are taken as an

example for illustration purpose. Moloslavsky et al. did disclose or suggest "wherein the parsing

step includes breaking up an electronic mail message nested in the complaint into the plurality

of components" because the apparatus and method disclosed by Miloslavsky et al. comprising:

an Extractor 6204 contains a <u>parser</u> 6206 for <u>parsing</u> the content of the e-mails obtained from e-mail server 6102. Extractor 6204 also contains a storage device for storing an algorithm 6208, which directs <u>parser</u> 6206 to extract appropriate information from the content of the e-mails in accordance with predetermined criteria. The extraction algorithm in extractor 6204 is changeable because the coding in algorithm 6208 could be changed. Examples of relevant information are: (a) Addresses: Typically, an e-mail has a portion that contains the addresses of the sender and recipient. Extractor 6204 directs <u>parser</u> 6206 to extract these e-mail addresses. (b) Time Stamp: Some e-mail contains the date and time an e-mail is sent. Extractor 6204 could direct <u>parser</u> 6206 to extract this information. This information may be more accurate that the time e-mail server 6102 receives the e-mail because some e-mails may be delayed for more than a day due to network problems. (c) Keyword: Extractor may direct <u>parser</u> to conduct a keyword search on the content of the e-mails. Example of keywords are name of relevant products and services provided by the company, special words such as "bugs", "virus", "crash" (for software products), "overheat" and "electric shock" (for hardware products), and words of urgent nature (such as "urgent", "ASAP", and "fast").

Since Miloslavsky et al. disclose a parser for parsing the content of the e-mails obtained from e-mail server in order to extract embedded complaint in a plurality of components, and as per definition, in context of messages, a parser is a device that can break the message into pieces, each of which consists of a header and sometimes some corresponding data. The examiner assumes, as result, Miloslavsky et al. did disclose the claimed limitations of "wherein the parsing step includes breaking up an electronic mail message nested in the complaint into the plurality of components" as recited in claims 1, 37, 46 and 51, as amended. Applicant

clearly failed to explicitly identify specific claim limitations, which would define a patentable

distinction over the prior art.

Furthermore, as per claims 28-34, 38- 44, 49, and 50, applicant argued that there is no

reason to combine Miloslavsky et al. in view of Donaldson (U.S. Pat. No.6,321,267).In response

to applicant's argument, the examiner recognizes that references can not be arbitrarily combined

and that there must be some reason why one skilled in art would be motivated to make the

proposed combination of primary and secondary references. *In re Nomiya, 184 USPO 607*

(CCPA 1975). However, there is no requirement that a motivation to make the modification be

expressly articulated. The test for combining references is what the combination taken as a whole

would suggest to one of ordinary skill in the art. *In re McLaughlin, 170 USPO 209 (CCPA*

1971). References are evaluated by what they suggest to one versed in the art, rather than by

their specific disclosures. *In re Bozek, 163 USPO 545 (CCPA 1969).* In this case, it would have

been obvious to one of ordinary skill in the art at the time the invention was made modify the

teachings of Miloslavsky with the teachings of Donaldson because Donaldson provides a method

wherein the header message can be located in order to eject email from unknown hosts that do

not list the recipient's email address header of the message. Therefore, the examiner asserts that

the cited prior arts (Miloslavsky et al., U. S. Pat. No.6,581,105, in combination with Donaldson,

U.S.Pat. No. 6,321,267) teach or suggest the subject matter broadly recited in claims 28-34, 38-

44, 49, and 50 as required under 35 U.S.C. 103 (a). See rejections of claims 1-52 as set forth

below.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

6.   Claims 27, 35-37, 45- 48, 51 and 52 are rejected under 35 U.S.C. 102(e) as being

anticipated by Miloslavsky et al. (U. S. Pat. No. 6,581,105, hereinafter Miloslavsky).

As per claims 27 and 37, Miloslavsky discloses a method for improving e-mail routing in

an Internet protocol network (See title and abstract). Similarly, the method comprising the steps

of: retrieving an email message (complaint) from a user (complainant) about an incident over the

computer network (See Fig.23 and corresponding text, col.39, 30-32, and col.40, lines 8-11);

parsing the complaint into a plurality of component, wherein the step of parsing includes

breaking up an electronic mail message nested in the complaint into the plurality components

(See Fig.22 component 6206 and col.36, line 61 through col.37, line 22); normalizing one of the

Plurality of components (See Fig.22 components 6210 and 6214 and corresponding text namely

col.37, lines 23-35 "Miloslavsky uses a formatted and deformatted process to normalize the

email components") ; and using an analysis protocol on the one of the plurality of components to

extract information relating to the complaint (See Fig.22 component 6204 in conjunction element

6208 and corresponding text).

As per claims 46 and 51, the claims have substantially the same limitation as claims 27

and 37. These limitations have already been addressed in the rejection of claims 27 and 37.

Therefore, they are rejected on similar grounds corresponding to the arguments given for the

rejected claims above.

As per claims 35 and 45, Miloslavsky discloses the claimed invention, wherein the

extracted information comprises one of a complaint tracking code, such as a URL that enables

computers all over the world to access it(See col.11, lines 17-27 and col.12, lines 15-20).

As per claim 36, Miloslavsky discloses the claimed invention, wherein the extracted

information forms a record of a database (See col.2, lines 12-22, lines 35-38, and col.41, lines

30-42).

As per claim 47, Miloslavsky discloses the claimed invention, wherein the analysis

protocol further includes an extractor adapted to isolate specific information in the message in

accordance with predetermined criteria (See Abstract lines 4-10, and col.2, lines 19-22).

As per claim 48, Miloslavsky discloses the claimed invention, wherein the extractor

searches for at least one of an IP address, a domain name, and an electronic mall address (See

col.2, lines 42-45).

As per claim 52, Miloslavsky discloses the claimed invention, wherein one of the specific

fields comprises a source IP address (See col.38, lines 49-53).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claims 28-34, 38-44, 49 and 50 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Miloslavsky et al. (U. S. Pat. No. 6,581,105, hereinafter Miloslavsky) in view

of Donaldson (U. S. Pat. No. 6,321,267).

As per claims 28 and 38, Miloslavsky teaches a method contains a parser (See Fig.22,

component 6206). Miloslavsky does not teach, wherein the parsing steps further includes

locating a header in one of the plurality of components.

Donaldson teaches a method for filtering junk mail (See the Title and the abstract lines 1-

2) including the feature of locating a header in one of the plurality of components (See col.4,

lines 4-7, and lines 25-26).

It would have been obvious to a person of ordinary skill in the art at the time Applicant's invention was made to modify the teachings of Miloslavsky with the teachings of Donaldson because Donaldson provides a method wherein the header message can be located in order to reject email from unknown hosts that do not list the recipient's email address header of the message.

As per claim 29, the combination of Miloslavsky and Donaldson, as modified, teaches the claimed invention, further including the step of locating a header keyword in the header (See Donaldson's col.4, lines 28-31).

As per claims 30 and 39, the combination of Miloslavsky and Donaldson, as modified, teaches the claimed invention, wherein the normalizing step includes removing, at least one character from the header based on the header keyword (See Donaldson's col.2, lines 38-41).

As per claims 31 and 40, the combination of Miloslavsky and Donaldson, as modified, teaches the claimed invention, further including the step of locating a Received line in one of the plurality of components (See Donaldson's col.2, lines 49-61, and col.3, lines 5-14).

As per claims 32 and 41, the combination of Miloslavsky and Donaldson, as modified, teaches the claimed invention, further including the step of validating a source IP address from the Received line (See Donaldson's col.4, lines 53-61).

As per claims 33, 42 and 43, the combination of Miloslavsky and Donaldson, as

modified, teaches the claimed invention, wherein the source IP address is validated by locating

one or more delimiters in the Received line (See Donaldson's Fig.3, col.3, lines39-41 and col.4,

lines 15-21).

As per claims 34 and 44, the combination of Miloslavsky and Donaldson, as modified,

teaches the claimed invention, further including the step of categorizing the complaint into a

category (See Donaldson's col.7, lines 31-64).

As per claim 49, the combination of Miloslavsky and Donaldson, as modified, teaches the

claimed invention, wherein the extractor Identifies an alphanumeric character associated with the

IP address, the domain name or the electronic mail address (See Donaldson's Figs.3 and 4 and

corresponding text).

As per claim 50, the combination of Miloslavsky and Donaldson, as modified, teaches the

claimed invention, wherein the message components include a header and body

(See Donaldson's Fig.3, and col.4, lines 28-30).

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086.

The examiner can normally be reached on Mon. to Fri. from 9 Am to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici can be reached on (571) 272- 4083. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHARLES RONES
PRIMARY EXAMINER

Patent Examiner
AU TC 2100

December 2, 2004